

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Pisutha-Arnond et al.)
)
For:	Message Alert System and)
	Method of Providing Message)
	Notification)
)
Serial No.:	09/504,135)
)
Filed:	February 15, 2000)
)
Examiner:	West, L.)
)
Art Unit:	2618)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

APPELLANTS' BRIEF

This brief is in furtherance of the NOTICE OF APPEAL, mailed on February 4, 2008.

Any fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37(c)):

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I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Motorola, Inc., a Delaware corporation.

II. RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

III. STATUS OF CLAIMS

A. Status of all claims in the proceeding

1. Clams rejected: 35, 37-42 and 44-48
2. Claims allowed: none
3. Claims withdrawn from consideration but not canceled: none
4. Claims objected to: none
5. Claims canceled: 1-34, 36 and 43

B. Identification of claims being appealed

The claims on appeal are: 35, 37-42 and 44-48

IV. STATUS OF ANY AMENDMENTS AFTER FINAL

No amendments have been filed after the most recent Office Action made final, dated November 2, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A first aspect of the present invention (claim 35), which is being appealed, pertains to a message alert system for a communication device (10) wherein the communication device comprises a processor (30) and a display (12) for displaying information. The message alert system includes a computer-readable medium (32, 34), and a routine stored in the computer-readable medium (page 5, lines 14-16) and configured for execution by the processor (30). The routine includes a first routine that receives a message intended for receipt by the communication device, the message comprising the information (100) (page 7, lines 19-20). The routine further includes a second routine that analyzes the message to determine a size thereof (124), and further analyzes the message to determine from type identifying data transmitted with the message (page 7, lines 18-21) whether the message is of a message type (102) (page 7, lines 20-22) for which the third routine is executed, wherein the criteria for the type of message is different than a criteria based on the size of the message. The routine still further includes a third routine that generates a display item for the message in accordance with the size thereof (126), if the message is of the type for which the third routine is executed (page 12, line 11 to page 13, line 8) (page 15, lines 8-16).

A further aspect of the present invention (claim 42), which is being appealed, pertains to a method in a communication device (10) having a display (12) for displaying information. The method includes the steps of receiving by the communication device a message intended for receipt by the communication device, the message comprising the information (100) (page 7, lines 19-20). The message is analyzed to determine a size thereof (124), and the message is further analyzed to determine from type identifying data transmitted with the message (page 7, lines 18-21) whether the message is of a message type (102) (page 7, lines 20-22) for which the generating step is executed, wherein the criteria for determining the type of message is different than a criteria based on the size of the message. A display item for the message is then generated

on the display in accordance with the size of the message (126), if the message is of the type for which the generating step is executed (page 12, line 11 to page 13, line 8) (page 15, lines 8-16).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 35, 37-42 and 44-48 have been improperly rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

2. Whether claims 35, 37-42 and 44-48 have been improperly rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

3. Whether claims 35, 37-42 and 44-48 have been improperly rejected under 35 U.S.C. 102(b) as being anticipated by Ichikawa et al. (US Patent No. 4,626,842).

VII. ARGUMENTS

A. Rejections under 35 U.S.C. §101

1. Whether claims 35, 37-42 and 44-48 have been improperly rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Regarding the Examiner's allegations as to the claims being directed to non-statutory subject matter, the Examiner has alleged that the claims are non-statutory because it is an abstract idea, directed solely to non-functional descriptive matter. The Appellant respectively disagrees. MPEP §2106.01 effectively distinguishes between functional descriptive matter and nonfunctional descriptive matter, where more specifically functional descriptive matter consists of data structures and computer programs which impart functionality when employed as a computer component. Alternatively, nonfunctional descriptive matter is defined through example as including music, literary works, and compilation or mere arrangement of data. When functional descriptive matter is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. Alternatively, when nonfunctional material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application

requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. However, what becomes most interesting is the analysis identified at MPEP §2106.01(I), where both data structures and computer programs identified as being stored on a computer-readable medium defines structural and functional interrelationships between the data structure/computer program and the rest of the computer, which permit the data structure's/computer program's functionality to be realized, which in turn makes it more than merely an abstract idea.

The Examiner appears fixated upon the concept of a tangible output, but the analysis involving a useful, tangible and concrete result comes into play in cases where the claims represent a judicial exception, i.e. laws of nature, natural phenomena and abstract ideas. While an abstract idea has been alleged, it can not be supported with the facts.

Claims 35 and 37-41

Claims 35, and indirectly claims 37-41 which depend from claim 35, provides for a computer-readable medium, and a routine stored in the computer-readable medium and configured for execution by the processor. The inclusion of routines stored in a computer readable medium and configured for execution by a processor moves the subject matter beyond an abstract idea, where the claimed structure is analogous to a computer program, which is stored on a computer readable medium that defines structural and functional interrelationships, as noted above (see MPEP §2106.01(I)), which in turn makes it more than merely an abstract idea. Consequently, the Examiner's attempt to apply the requirement for a tangible output is misplaced.

More specifically, the present claims include routines, which involve the receipt of a message, the analysis of a message, and the corresponding generation of display item based upon the analysis. As such, contrary to the Examiner's assertions, claims 35 and 37-41 represent statutory subject matter.

Claims 42 and 44-48

Similarly, claim 42, and indirectly claims 44-48 which depend from claim 42, provide for more than an abstract idea, as it involves a claimed method in a communication device. Consequently, the Examiner's attempt to apply a tangible output test is misplaced. However, even if one were to attempt to apply a tangible output test, the same would be satisfied by the display item identified as being generated on the display. As such, contrary to the Examiner's assertion, claims 42 and 44-48 similarly represent statutory subject matter.

Because each of the groupings of claims represent at least one of a new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, and do not represent one of the judicial exception to patentability, for example, they are not directed to an abstract idea, the Examiner has failed to support the rejection of the claims as being directed to a non-statutory invention, and therefore the Examiner's final rejection of claims 35, 37-42 and 44-48 on that basis should be overturned.

B. Rejections under 35 U.S.C. §112

2. Whether claims 35, 37-42 and 44-48 have been improperly rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Claims 35, 37-42 and 44-48

In regards to the Examiner's rejection of the claims based upon 35 USC 112, first paragraph, the Examiner appears to be looking for the exact phrasing that is being amended into the claims as being present in the disclosure materials. However, support for the exact phrasing is not required. It is only required that the ultimately claimed language be supported in such a way that one skilled in the art would understand that the inventors had possession of the later claimed invention at the time of filing.

More specifically, as articulated by the Federal Circuit, the test for determining

compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). It is well settled, that a determination as to whether the originally filed disclosure of the application reasonably conveys to the artisan an indication that the inventor had possession of the claimed subject matter, does not require that the claimed subject matter be described identically. Precisely how close the original description must come in order to comply with the description requirement must be determined on a case-by-case basis. In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984) (emphasis added).

The first phrase for which the Examiner raises a concern is “wherein the type of message is different than the size of the message”, while the exact phrase may not be expressly provided, the phrase is a fair characterization of what one skilled in the art would understand that the inventors possessed at the time the application was filed relative to the subsequently claimed invention. It is specifically noted, that an explicit determination of size separate from a determination of type was already provided in the claims as originally filed (see at least original claims 35 and 36). The separate determinations fairly identify to one skilled in the art, the intention that the two characteristics are distinct. It is only when the Examiner attempts to converge the separately articulated features as being representative of the same thing, in order to read onto the claims the teachings of a reference which only attempts to show a distinction based upon size, that it becomes necessary to more clearly identify that message type represents a characteristic separate from message size. Nevertheless, the separate articulated determination would clearly set forth to one skilled in the art that a determination based on type, as provided in the claim is based on a determination criteria, that is different from size, especially where a separate determination based upon size is separately expressly provided.

In regards to the Examiner’s reference to “quickview”, where the Examiner alleges that the same is performed based on type of message which is directly based on the size of the message, the applicants are unable to reach the same conclusion based upon the a direct reading of the relevant sections of the specification, where one of the particular sections indicate that a

particular channel can be specified by the user as a “quickview” channel (see page 12, lines 12-21). Another section then indicates, that if the message should be accorded quickview status, then it is further analyzed to determine its size (see page 12, lines 22-24). However there is no linkage to a determination of type being directly based on size. Such a characterization, while suggested by the Examiner (apparently inappropriately so), is not supported by the actual language used in the specification.

The second phrase for which the Examiner raises a concern is “criteria of the type”. However the original disclosure supports both “analyzing” in order “to determine”. Most determinations are based upon some form of criteria. As defined by the American Heritage Dictionary, criteria means “[a] standard, rule, or test on which a judgment or decision can be based”. As such, because a determination (“to determine”) is originally provided by the claim, it is fair that the determination should be made based upon some criteria. Therefore usage of the term is fair in the claimed context, and more importantly the particular criteria identified are fairly associated with the determination as originally disclosed in the specification. Consequently, the particular phrase is in fact supported as required under 35 USC 112, first paragraph, and therefore no new matter is present, and the particular phrases specifically identified by the Examiner are appropriately present.

In responding to applicants’ arguments, the Examiner’s comments appear to be at odds with one another. On one hand, the Examiner is suggesting that the applicant has inappropriately relied upon extrinsic evidence, but on the other hand, the Examiner alleges that argument does not replace evidence (apparently suggesting that the applicants’ response failed to provide evidence to support their arguments. Unfortunately, not only are the two points raised by the Examiner, apparently contradictory in their assertions, but in the case of the alleged extrinsic evidence, the examiner fails to identify which evidence raised by the applicant is apparently problematic.

The applicants assume that that the Examiner is referring to the applicants’ reference to a dictionary definition for the term “criteria” as being the extrinsic evidence that the Examiner found to be offensive. However, the applicants would contend that dictionary definitions in support of remarks rebutting the Examiner’s rejection are entirely appropriate in the present

circumstances. In order to determine whether the added claim language constitutes new matter, one needs to evaluate whether the meaning of the words being added to the claims are fairly represented by an appropriate teaching in the specification as originally filed. It would appear entirely appropriate to understand the meaning of the terms being added to the claims, as well as potentially the meaning of originally present portions of the specification, in order to evaluate whether the added language in fact represent new matter. A dictionary definition would appear to be permissible in addressing the allegation of new matter.

Furthermore, the particular boiler plate section from the MPEP cited by the Examiner, in response to an alleged lack of evidence on the part of the applicants in responding to the Examiner's rejection based on alleged new matter, appears to have been misapplied. The particular section deals with cases in which a prima facie case of obviousness has been established by the Examiner. However, no rejection by the Examiner based upon obviousness has been alleged. Still further, contrary to the Examiner's assertions, the applicants did not merely rely upon argument in responding to the Examiner's rejection. As noted above, the applicant provided reference to dictionary definitions as well as citations to sections of the specification in refuting the Examiner's allegations. Consequently, it is not clear how to respond to the Examiner's comments, nor is it clear that the Examiner's final rejection has been fully responsive to applicant's previous response. In any event, any clarification concerning the Examiner's position would be most helpful, in order that the Examiner's specific issues with any of the applicants' previous remarks can be more fully addressed.

Nevertheless, as it presently stands, the applicants believe that the rejection alleging new matter has been added to the claim, which was said to not be supported by the original specification, would appear to be in error. As such, the applicants would respectfully request that the board overturn the Examiner's corresponding rejection.

C. Rejections under 35 U.S.C. §102

3. Whether claims 35, 37-42 and 44-48 have been improperly rejected under 35 U.S.C. 102(b) as being anticipated by Ichikawa et al. (US Patent No. 4,626,842).

Claims 35, 37-42 and 44-48

In response to the Examiner's continued rejection of claims 35, 37-42 and 44-48, under 35 U.S.C. §102(b), as being anticipated by Ichikawa et al., US Patent No. 4,626,842, the applicants contend that contrary to the Examiner's assertions, even under the Examiner's most recent attempt to find an equivalent teaching in the cited reference with respect to a determination of type, the presently articulated rejection continues to fail to make known or obvious each and every feature of the claims.

Remarkably, in the portion of the final rejection, which responds to applicants' arguments raised in the immediately prior response, the Examiner simply suggests that all of applicants' arguments are based upon claim distinctions associated with claim language that is being additionally rejected upon the allegations that the claim language represents new matter, and therefore the Board of Appeals prior ruling continues to be applicable. However, the Board of Appeal's prior ruling was based upon claims, which are no longer pending in the present application. Such a statement by the Examiner would suggest that the Examiner is indicating that his rejection based upon an alleged anticipation is not based upon the most recent amended language, but that the rejection is based upon the language in the claims prior to the more recent amendments. As such, the comments from the Examiner appear to be an admission that the most recent rejection does not apply to the claims as presently pending. Clarification from the Examiner is earnestly sought.

Nevertheless, most recently the Examiner appears to attempt to rely upon the addressing of a message as being equivalent to a determination of message type, in a manner which is different from a criteria based upon size, where in the more recent official actions the Examiner relies upon a citation to col. 2, lines 26-46 of Ichikawa et al., '842. However, contrary to supporting the Examiner's position, the specifically cited portion in fact teaches away from the Examiner's conclusions.

More specifically, the most recent attempt at articulating an equivalent teaching for the claimed determination based upon message type fails to make known or obvious the same. The most recent alleged equivalent structure does not refer to the type of message, but alternatively

relates to the intended recipient of the message. If one is not the intended recipient of the message, then one does not receive the message as provided in connection with the first routine (claim 35) or the claimed step of receiving a message comprising information (claim 42). A type of message does not change based upon the intended recipient. Alternatively, the identified recipient affects the routing and the receipt of the message.

Interestingly, even the reference treats the message frames (I) as being separate from the subscriber's address frame (N), in connection with discussing the data structure of the paging channel (see FIGs. 2a, 2b and 2c, and col. 2, lines 47-50). Correspondingly, as one skilled in the art would be led to understand from the teachings of the cited reference, the type of message would be distinct from any attempted categorization or classification relative to the subscriber's address. As a result, an attempt to equate the manner in which the message is addressed as making known or obvious the claimed feature of a message type (i.e. type of message) and any determination based thereupon can not be supported in view of the teachings reasonably attributable to the relied upon reference. Consequently, the Examiner's final rejection of the claims, based upon the most recent basis for rejection should be set aside and/or withdrawn.

As noted above, in addressing the specific section of the cited reference noted by the Examiner, namely col. 2, lines 26-46, the section refers to a "signal intercepted", because it is not until an address match is determined that the signal is in fact received, where prior to receipt of the message, "the decoder checks to see if the receiver is being addressed". Upon a determined address match, the message is received, an alert signal is produced, and a visual indication of the received signal on a per 10-digit basis is provided. Consequently, a determination of whether an intercepted signal should be received can hardly be a determination of a type of message that is received. In other words, communication signals that are not intended for the communication device are generally ignored and not received. Nevertheless, in an attempt to make the same even more clear, the applicants have amended the claims to more clearly identify the message that is being received as one that is intended for receipt by the communication device.

As such, the Examiner has failed to support a rejection based upon an alleged anticipation, where the relied upon reference fails to make known or obvious each and every

feature of independent claims 35 and 42, as well as the corresponding dependent claims 37-41 and 44-48.

Conclusion

Because the claims are directed to patentable subject matter, the claims as presently provided are supported by the specification as originally filed, and the relied upon reference fails to make known each and every feature of the claims, the final rejection of the claims should be withdrawn as being improper. The applicants would respectfully request that the Examiner's decision to finally reject the presently pending claims be overturned, and that the claims be permitted to proceed to allowance.

Respectfully submitted,

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VIII. APPENDIX OF CLAIMS

The following is the text of the claims involved in this appeal:

1-34 (canceled)

35. A message alert system for a communication device wherein the communication device comprises a processor and a display for displaying information, comprising:

a computer-readable medium; and

a routine stored in the computer-readable medium and configured for execution by the processor, the routine comprising:

a first routine that receives a message intended for receipt by the communication device, the message comprising the information;

a second routine that analyzes the message to determine a size thereof, and further analyzes the message to determine from type identifying data transmitted with the message whether the message is of a message type for which the third routine is executed, wherein the criteria for the type of message is different than a criteria based on the size of the message;

a third routine that generates a display item for the message in accordance with the size thereof, if the message is of the type for which the third routine is executed.

36. (canceled)

37. The message alert system of claim 35, wherein the routine further comprises an initialization routine that specifies the message type for which the third routine is executed.

38. The message alert system of claim 35, wherein the generated display item comprises a reproduction of the message when the second routine determines that the size of the message is less than a predetermined size.

39. The message alert system of claim 35, wherein:
the generated display item comprises a reproduction of the message when the second routine determines that the size of the message is greater than a predetermined size; and
the routine comprises a fourth routine that provides the generated display item to the display for a predetermined time.

40. The message alert system of claim 39, wherein:
the routine comprises a fifth routine that generates a further display item that comprises a portion of the message when the second routine determines that the size of the message is greater than a predetermined size; and
the routine comprises a sixth routine that provides the further display item to the display after the predetermined time has elapsed.

41. The software system of claim 35, wherein:
the message is transmitted to the communication device via a network; and

the network is a broadcast network.

42. A method in a communication device having a display for displaying information, the method comprising the steps of:

receiving by the communication device a message intended for receipt by the communication device, the message comprising the information;

analyzing the message to determine a size thereof, and further analyzing the message to determine from type identifying data transmitted with the message whether the message is of a message type for which the generating step is executed, wherein the criteria for determining the type of message is different than a criteria based on the size of the message; and

generating on the display a display item for the message in accordance with the size thereof, if the message is of the type for which the generating step is executed.

43. (canceled)

44. The method of claim 42, further comprising the step of specifying the message type for which the third routine is executed.

45. The method of claim 42, wherein the generated display item comprises a reproduction of the message when the analyzing step determines that the size of the message is less than a predetermined size.

46. The method of claim 42, wherein:

the generated display item comprises a reproduction of the message when the size of the message is greater than a predetermined size; and

the method further comprises the step of providing the generated display item to the display for a predetermined time.

47. The method of claim 46, further comprising the steps of:

generating a further display item that comprises a portion of the message when the size of the message is greater than a predetermined size; and

providing the further display item to the display after the predetermined time has elapsed.

48. The software system of claim 42, wherein the message is transmitted to the communication device via a broadcast network.

IX EVIDENCE APPENDIX

None

X RELATED PROCEEDINGS APPENDIX

None